

Dec-16-2003 03:44pm From-Cozen O'Connor

+215 665 7291

T-586 P.001/005 F-872

PHILADELPHIA  
ATLANTA  
CHARLOTTE  
CHERRY HILL  
CHICAGO  
DALLAS  
DENVER  
LAS VEGAS  
LONDON  
LOS ANGELES



A PROFESSIONAL CORPORATION

1900 MARKET STREET PHILADELPHIA, PA 19103-3508 215.665.2000 800.523.2900 215.665.2013 FAX www.cozen.com

RECEIVED  
DEC 16 2003  
OFFICIAL

NEWARK  
NEW YORK  
SAN DIEGO  
SAN FRANCISCO  
SEATTLE  
TRENTON  
WASHINGTON, DC  
WEST CONSHOHOCKEN  
WICHITA  
WILMINGTON

### FACSIMILE

FROM: Brian L. Belles  
SENDER'S PHONE: 215.665.7244  
# OF PAGES (INCLUDING COVER):  
DATE: December 16, 2003  
TIMEKEEPER NO.: 1763  
SENDER'S FAX: 215.701.2044  
FILE NAME: Akron  
FILE #: 108430.019A

RECIPIENT(S)	PHONE	FAX
Examiner Gergory Webb - USPTO		703 872-9306

MESSAGE: FOR SERIAL NO. 10/053,364 METHOD AND SYSTEM FOR CHEMICAL INJECTION IN SILICON WAFER PROCESSING

Attached is Response to Restriction Requirement dated 11/17/03 on 3 pages plus transmittal sheet on one page and this fax cover sheet for a total of 5 pages

IF YOU DO NOT RECEIVE ALL PAGES, PLEASE CALL 215.665.2000 or 800.523.2900 IMMEDIATELY.

THIS TRANSMISSION IS ALSO BEING SENT VIA:

- ☐ Regular Mail
- ☐ Certified Mail
- ☐ Hand Delivery
- ☐ Overnight Mail
- ☐ Federal Express

#### NOTICE

The information contained in this transmission is privileged and confidential. It is intended for the use of the individual or entity named above. If the reader of this message is not the intended addressee, the reader is hereby notified that any consideration, dissemination or duplication of this communication is strictly prohibited. If the addressee has received this communication in error, please return this transmission to us at the above address by mail. We will reimburse you for postage. In addition, if this communication was received in the U.S., please notify us immediately by phoning and asking for the Fax Center.

PTO/SB/21 (08-03)

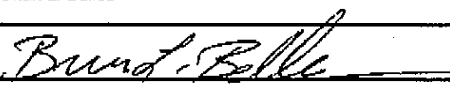
Approved for use through 07/31/2006. OMB 0851-0031

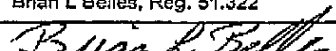
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/053,364
		Filing Date	Jan. 18, 2002
		First Named Inventor	Chang Kuo
		Art Unit	1751
		Examiner Name	Gergory E. Webb
Total Number of Pages in This Submission	4	Attorney Docket Number	108430.019A

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Brian L. Belles
Signature	
Date	Dec. 16, 2003

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Brian L. Belles, Reg. 51,322		
Signature		Date	Dec. 16, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**DOCKET NO. 108430.019A**

Serial No. 10/053,364

Response to Office Action of 11/17/03

**PATENT**

RECEIVED

U.S. PATENT &amp; TRADEMARK OFFICE

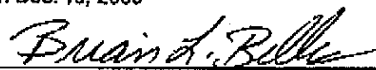
DEC 16 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Art Unit : 1751 Docket: 108430.019A  
Examiner : Gregory E. Webb  
Serial No. : 10/053,364  
Filed : January 18, 2002  
Inventor : Chang Kuo et al.  
Title : METHOD AND SYSTEM FOR CHEMICAL INJECTION IN SILICON  
WAFER PROCESSING

OFFICIAL

I hereby certify that this correspondence is being  
facsimile transmitted to the Patent and Trademark Office  
on Dec. 16, 2003

  
Brian L. Belles, Reg. No. 51,322

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Office communication of November 17, 2003, Applicants elect with traverse Invention I, which is drawn to the apparatus and consists of Claims 1-9.

Applicants traverse the restriction requirement because the inventions as grouped are not independent and distinct. According to the Manual of Patent Examining Procedure ("MPEP"), section 802.01, the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed. Stated in simplest terms, "independent" means "not dependent." See MPEP § 802.01 ¶ 3. In the present case there is a disclosed relationship between Inventions I and II. The claims of Invention II are directed toward a process while the claims of Invention I are directed toward a system for carrying out the process of Invention II. It is a well established principle that a group of claims directed toward a product and a group of claims directed toward a system for carrying out that process are dependent inventions. In fact, this dependency is explicitly recognized in the MPEP. See MPEP § 802.01 ¶ 6. Thus, Inventions I and II are not independent.

**DOCKET NO. 108430.019A****PATENT**

Serial No. 10/053,364

Response to Office Action of 11/17/03

However, according to MPEP § 802.01, dependent inventions may nonetheless be properly divided if they are in fact "distinct." According to MPEP § 806.05(e), "a process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process as claimed can be practiced by another *materially* different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another materially different process." See MPEP § 806.05(e) (emphasis added). "The burden is on the examiner to provide reasonable examples that recite material differences." MPEP § 806.05(e), ¶ 8.17.

In accordance with this burden, the Office Action first states that "the process claimed can be practiced with a device that does not require mixing." This statement is incorrect and ignores the express language of process claim 10. The process as claimed specifically requires the step of "mixing the first chemical with the mixture of the hot water and the cold DI water..." See claim 10. In order for an apparatus to perform this mixing step, it is imperative that the apparatus contain some type of means to mix the first chemical with the hot and cold DI water. To state that that the process, as claimed, can be performed by a simple DI water system with no chemical mixing blatantly ignores specific limitations present in the claimed process. Such practice is improper. See MPEP § 806.01 (stating that it "is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence").

In further support of its burden, the Office Action additionally states that "the applicant's apparatus could be used for methods beyond cleaning substrates." This statement is incorrect and ignores the express language of process claim 10. The system as claimed specifically requires a "process tank for cleaning, rinsing, and/or drying silicon wafers." See claim 1. To state that the system can be used to "for methods beyond cleaning semiconductors," such as being used as a "consumer dishwasher and can be used in methods of cleaning silverware or other home items," is blatantly ignores the specific limitations present in the claimed system. Such practice is improper. See MPEP § 806.01 (stating that it "is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence"). Moreover, the burden is on the examiner to provide reasonable

**DOCKET NO. 108430.019A****PATENT**

Serial No. 10/053,364

Response to Office Action of 11/17/03

examples that recite material differences. See MPEP § 806.05(e). The example given by the Examiner that the system can be used as a normal dishwasher is clearly unreasonable. The system claimed is an expensive and complicated system, costing as much as hundreds of thousands of dollars. A reasonable human being is not going to buy the claimed system and use it to wash dishes. Under the examiner's rationale, every system in the world can be used for a different process, such as the process of filling a hole in the ground or providing a ladder upon which someone can stand. Such an interpretation of the MPEP is impermissible.

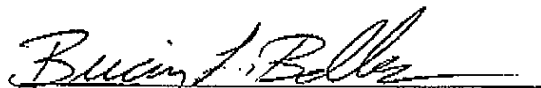
Thus, the distinctions recognized in the Office Action are improper and do not show that the claimed inventions are distinct. Thus, the burden is now on the Examiner to document another materially different process or apparatus or withdraw the restriction requirement. See MPEP § 806.05(e), ¶ 8.17.

Finally, according to MPEP § 803, "if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." See MPEP § 803 (emphasis added). In the present application, Inventions I and II are very closely related. Any search performed for the apparatus will uncover the relevant prior art for the process. In fact, it is likely that the same prior art will be cited against both the process and apparatus claims if a rejection for the claims of the present application issues.

For these reasons, following the instructions of the MPEP, the restriction requirement is improper and should be withdrawn.

Respectfully Submitted,

Date:

12/16/03

Brian L. Belles

Reg. No. 51,322

Cozen O'Connor

1900 Market Street

Philadelphia, PA 19103

(215) 665-7244

BLB/kf